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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/098,691	03/14/2002	Paulina Glavich	0112300-994	5155
29159	7590	07/13/2004	EXAMINER	
BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135			JONES, SCOTT E	
			ART UNIT	PAPER NUMBER
			3713	

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

JW

# Office Action Summary

Application No.

10/098,691

Applicant(s)

GLAVICH ET AL.

Examiner

Scott E. Jones

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2004.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1-62 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 14 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to the amendment filed on April 22, 2004 in which applicant amends claims 16, 20, 24, and 55 and responds to the claim rejections. Claims 1-62 are pending.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58 are rejected under 35 U.S.C. 102(e) as being anticipated by Fasbender et al. (U.S. 2002/0086725 A1).

Regarding Claims 1, 9, 12, 17, 21, and 55:

- a display device (Figs. 2-11);
- a primary/base game displayed on the display device (¶ 17);
- a set of reels in the primary/base game having a plurality of symbols (¶'s 17-21 and 36);
- a plurality of primary/base game awards associated with the primary/base symbols (¶'s 18, 35, 42, 45, and 55);
- a first secondary/bonus game(20) displayed on the display device (Abstract, Fig. 1, ¶'s 2, 17-21, 36, and 58);

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- a set of reels in the first secondary/bonus game having a plurality of symbols which include at least one different symbol than the primary/base symbols (§ 37);
- a second secondary/bonus game displayed on the display device (Abstract, Fig. 1, ¶'s 2, 17-21, 36, and 58);
- a plurality of secondary/bonus awards associated with the secondary/bonus symbols in each of the secondary/bonus games, wherein the secondary/bonus awards are different than the primary/base awards (§ 45); and
- a processor causes the display device to display the set of reels in the primary/base game which are randomly determined, provides any primary/base awards associated with the primary/base symbols indicated on the reels in the primary/base game, causes the display device to remove/replace the set of reels in the primary/base game with the set of reels in the first secondary/bonus game when a first triggering event occurs in the primary/base game, randomly determines the secondary/bonus symbols indicated by the set of reels of the first secondary/bonus game, provides any secondary/bonus awards associated with the secondary/bonus symbols indicated on the reels in the first secondary/bonus game, and causes the display device to replace the set of reels in the first secondary/bonus game with the second secondary/bonus game when a second triggering event occurs in the first secondary/bonus game, wherein the primary/base game does not include a triggering event which causes the processor to cause the display device to display the second secondary/bonus game (Abstract, Fig. 1, ¶'s 2, 17-21, 36-37, and 57-58).

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Regarding Claims 2 and 7:

- a plurality of the secondary/bonus symbols of the first secondary/bonus game are different than the primary/base symbols (§ 37).

Regarding Claims 3, 8, 10, 14, 18, and 22:

- all of the secondary/bonus symbols of the first secondary/bonus game are different than the primary/base symbols (§ 37).

Regarding Claim 5:

- the second secondary game includes second secondary symbols which are different than the secondary symbols of the first secondary game (§ 37).

Regarding Claims 25 and 40:

- at least one of the secondary awards is larger than all of the primary awards (§ 45).

Regarding Claims 26 and 41:

- the secondary awards in the secondary game are different than the secondary awards in the first secondary game (§ 45).

Regarding Claims 27 and 42:

- at least one of the secondary awards in the second secondary game is greater than all of the secondary awards in the first secondary game (§ 45).

Regarding Claims 28, 43, and 55:

- a probability of obtaining a winning combination of symbols associated with each winning combination of the primary symbols in the primary game and each winning combination of the secondary symbols in the first secondary game,

wherein the probabilities associated with the winning combinations of secondary symbols are different than the probabilities associated with the winning combinations of primary symbols (§ 45).

Regarding Claims 29, 44, and 56:

- at least one of the probabilities associated with the winning combinations of secondary symbols in the first secondary game is greater than all of the probabilities associated with the winning combinations of primary symbols in the primary game (§ 45).

Regarding Claim 57:

- the probabilities associated with winning combinations of secondary symbols in the second secondary game are different than the probabilities associated with winning combinations of secondary symbols in the first secondary game (§ 45).

Regarding Claim 58:

- at least one of the probabilities associated with the winning combinations of secondary symbols in the second secondary game is greater than all of the probabilities associated with the winning combinations of secondary symbols in the first secondary game (§ 45).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1).

Fasbender et al. discloses that as discussed above regarding Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58. Fasbender et al. seems to lack explicitly disclosing that a gaming device is operated through the Internet. However, operating gaming machines over a data network such as the Internet was well know to one having ordinary skill in the art at the time of the applicant's invention. One would be motivated to do so because this provides an efficient and cost effective way to collect personal data from a game player or to reconfigure a gaming machine thereby possibly reducing the number of employees required to run a casino.

6. Claims 4, 6-11, 13, 17-24, 30-39, 45-54, and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1) in view of Watts et al. (U.S. 5,775,692).

Fasbender et al. discloses that as discussed above regarding Claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58. Fasbender et al. seems to lack explicitly disclosing:

Regarding Claims 4, 6, 9, 11, 13, 17, 21, and 59:

- the gaming device includes less secondary/bonus symbols of the first secondary/bonus game than the primary/base symbols (Column 1, lines 59-67, Column 2, lines 35-39).

Regarding Claims 20 and 24:

- operating gaming machines over a data network such as the Internet.

Watts et al. teaches of a gaming machine having a base game and secondary game(s). A predetermined outcome in the primary game triggers a first secondary game. Additional stages in

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the secondary game(s) can be implemented that are not triggered by the predetermined outcome in the primary game. Watts et al. and Fasbender et al. are analogous art since both describe slot machines having base and bonus games. Furthermore, Watts et al. teaches:

Regarding Claims 4, 6, 9, 11, 13, and 21:

- the gaming device includes less secondary/bonus symbols of the first secondary/bonus game than the primary/base symbols (Column 1, lines 59-67, Column 2, lines 35-39).

It would have been obvious to one having ordinary skill in the art, at the time of the applicant's invention, to incorporate fewer symbols in a bonus/secondary game as taught in Watts et al. in Fasbender et al. One would be motivated to do so because having less symbols on a secondary/bonus reel improve the overall odds of a player receiving an award in the bonus/secondary round.

Regarding claims 20 and 24, operating gaming machines over a data network such as the Internet was well know to one having ordinary skill in the art at the time of the applicant's invention. One would be motivated to do so because this provides an efficient and cost effective way to collect personal data from a game player or to reconfigure a gaming machine thereby possibly reducing the number of employees required to run a casino.

### ***Response to Arguments***

7. Applicant's arguments filed April 22, 2004 have been fully considered but they are not persuasive.



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8. Applicant's arguments, see pages 7, 8, 10, and 19, filed April 22, 2004, with respect to objection to claims 16, 20, and 24 have been fully considered and are persuasive. The objection to claims 16, 20, and 24 has been withdrawn.

9. Applicant respectfully traverses the rejection to claims 1-3, 5, 12, 14-15, 25-29, 40-44, and 55-58 under 35 U.S.C. 102(e) as being anticipated by Fasbender et al. (U.S. 2002/0086725 A1).

Regarding claim 1, Applicant alleges Fasbender does not disclose, teach, or suggest replacing the entire set of reels from a primary game with a set of reels from one or more bonus games or replacing all of the symbols with the primary game with different symbols in one or more bonus games. Applicant admits Fasbender discloses a bonus game where certain symbols on the selected payline in the primary game, which triggered the bonus game, may be replaced in the bonus game. Furthermore, the examiner notes Fasbender also discloses selecting one or more paylines to play the game. Therefore, if all paylines are selected and certain symbols occur on each of the paylines, then the entire set of reels or simulated reels may be replaced.

Fasbender also discloses the symbols in the primary game may be different than the symbols in the bonus game. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 9-11, Applicant relies on similar arguments to overcome the rejection as stated above for claim 1. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 12 and 13-16, in addition to the arguments presented for claim 1, Applicant alleges Fasbender does not disclose, teach, or suggest removing the primary reels on

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the display device and replacing the primary reels on the display device and replacing the primary reels with secondary reels in the first secondary game upon a first triggering event in the primary game, nor removing the secondary reels on the display device in a first secondary game and replacing the secondary reels with a second secondary game upon a second triggering event in the first secondary game. However, the examiner respectfully disagrees. The examiner interprets the terms replacing in claim 1 and removing in claim 12 to be analogous because in order to replace the reels in the primary game with the reels of the secondary game the primary reels must be removed to do so.

Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 17-20, Applicant relies on similar arguments to overcome the rejection as stated above for claim 1. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 21-24, Applicant relies on similar arguments to overcome the rejection as stated above for claim 1. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 55-58, Applicant relies on similar arguments to overcome the rejection as stated above for claim 1. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

Regarding claims 59-62, Applicant relies on similar arguments to overcome the rejection as stated above for claim 1. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

10. Applicant respectfully traverses the rejection to claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1). Applicant alleges claim 16 is allowable for at least the same reasons as set forth with respect to claim 12. Please see the arguments in item No. 9 above. Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

11. Applicant respectfully traverses the rejection to 4, 6-11, 13, 17-24, 30-39, 45-54, and 59-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fasbender et al. (U.S. 2002/0086725 A1) in view of Watts et al. (U.S. 5,775,692).

Applicant alleges Watts does not disclose, teach, or suggest replacing any sets of reels with another set of reels and that each of claims 4, 6-8, 9-11, 13, 17-20, 21-24, 30-34, 35-39, 45-49, 50-54, and 59-62 are allowable for at least the same reasons as presented for claim 1. However, the examiner does not rely on Watts to teach the feature Fasbender discloses as discussed above in item No. 9. The examiner relies on Watts to teach the gaming device includes less secondary/bonus symbols of the first secondary/bonus game than the primary/base symbols (Column 1, lines 59-67, Column 2, lines 35-39). Therefore, the examiner maintains the rejection as stated in Office Action, Paper No. 12 and repeated above.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott E. Jones whose telephone number is (703) 308-7133. The examiner can normally be reached on Monday - Thursday, 6:30 A.M. - 5:00 P.M..

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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JOHN M. HOTALING, II  
PRIMARY EXAMINER